

EXHIBIT R

Case 2:04-cv-01005-PGC Document 68
UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,686	03/19/2004	Richard J. Morris	1915.17US03	8616
24113	7590	11/22/2005	EXAMINER	
PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A. 4800 IDS CENTER 80 SOUTH 8TH STREET MINNEAPOLIS, MN 55402-2100			SLACK, NAKO N	
			ART UNIT	PAPER NUMBER
			3635	

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

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Examiner

Naoko Slack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-13 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-13 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/25/2005</u> | 6) <input type="checkbox"/> Other: _____ |

Reissue Application

In view of applicant's Housekeeping Amendment received July 30, 2005, claims 1, 14-20, and 22 have been canceled as requested. Amendments to claims 2, 3, 6, 8, and 9 have been entered. Claims 2-13, and 21 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-11, 13 rejected under 35 U.S.C. 102(b) as being clearly anticipated by US Patent 5304095 to Morris.

Claim 2:

Morris discloses a roof system comprising an overlays of plywood (22) and shingles (24), a top panel (62), and a batten (12, 14) disposable between the panel and overlays, the batten comprising generally planar first plies (30, 32) and a second ply (34), the first and second plies cooperating to define a multiplicity of passages extending generally transversely to a longitudinal axis of the batten, and in which the second ply includes a multiplicity of cross plies (sides of troughs) extending between the first plies.

Claim 3:

Morris discloses a roof system comprising an overlays of plywood (22) and shingles (24), a top panel (62), and a batten (12, 14) disposable between the panel and overlays, the batten comprising generally planar first plies (30, 32) and a second ply (34), the first and second plies cooperating to define a multiplicity of passages extending generally transversely to a longitudinal axis of the batten, and in which the second ply is generally convoluted (Figure 9).

Claims 4 and 5:

A plurality of first plies and plurality of layers are present (Figure 8).

Claim 6:

Adjacent layers are hingedly connected by a hinge line (48, Figure 8) extending generally parallel to the batten longitudinal axis.

Claim 7:

The hinge line is defined by a slice extending through the second ply and one of the first plies (as best shown in Figure 8).

Claims 8 and 9:

Figure 2 discloses first and second hinge lines (48 on the right longitudinal edge and on the left longitudinal edge, the ventilator in folded position). As best shown in Figure 8, the hinge line on each side is defined by a slice extending through one of the first plies and the second ply. One first ply is intact (62, Figure 8).

Claims 10, 11, 13:

The layers are stacked and fastened together with fastening means such as staples (38, Figure 5).

Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 3,878,574 to Erickson.

Claim 21:

Erickson discloses a plurality of stacked layers, each layer comprising a generally planar first ply (26, Figure 5) and a second ply (12, Figure 5) cooperating with the first ply to define a multiplicity of passages (41, Figure 5), the passages extending generally transversely to a longitudinal axis of the spacer, the layers fastened together by stitching (22), adjacent layers connected by a hinge line (29) extending generally parallel to the spacer longitudinal axis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5304095 to Morris in view of US Patent 3,647,606 to Notaro.

While Morris does not specify the use of stitching to fasten the layers, such a fastener for layers is well known in the art. For example, Notaro discloses a multi-

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layered member capable of being disposed between a roof decking and an exterior roof material, the member comprising a plurality of stacked, separate layers (21, 22, 23, Figure 7) fastened together by stitching (column 4, line 58), each layer comprising a generally planar first ply (21, Figure 7) and a second ply (22, Figure 7) cooperating with the first ply to define a multiplicity of passages, the passages extending generally transversely to a longitudinal axis of the spacer. In view of Notaro, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply stitching to Morris's layers to strengthen and rigidize the layers for improved handling, as Morris is interested in facilitating installation.

Prior Art

The following references are considered relevant prior art:

US Patent 5,879,788 to Barnes,

US Patent 5,591,933 to Li et al.,

US Patent 4,817,506 to Cashman,

US Patent 3,236,170 to Meyer et al.,

UK Patent GB2127060A to Matthews et al., and

UK Patent GB2243169A to Blench.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naoko Slack whose telephone number is (571) 272-6848. The examiner can normally be reached on Mon-Fri (6:00 am-2:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on (571) 272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Naoko Slack
Primary Examiner
Art Unit 3635

NS
October 31, 2005